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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,870	01/12/2001	Stanley Kin-Sui Cheng	LWC-174	2420

7590 11/27/2002
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EXAMINER

WONG, EDNA

ART UNIT PAPER NUMBER

1741

DATE MAILED: 11/27/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,870

Applicant(s)

CHENG, STANLEY KIN-SUI

Examiner

Edna Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: _____

This is in response to the Amendment dated November 13, 2002. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Specification

The disclosure has been objected to because of minor informalities.

The objection to the disclosure has been withdrawn in view of Applicant's amendment.

Claim Objections

Claims **4-5 and 11** have been objected to because of minor informalities.

The objection of claims 4-5 and 11 has been withdrawn in view of Applicant's amendment.

Claim Rejections - 35 USC § 112

I. Claims **11 and 13** have been rejected under 35 U.S.C. 112, first paragraph.

The rejection of claims 11 and 13 under 35 U.S.C. 112, first paragraph, has been withdrawn in view of Applicant's amendment.

II. Claims **11 and 13** have been rejected under 35 U.S.C. 112, second paragraph,

as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claims 11 and 13 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicant's amendment.

Claim Rejections - 35 USC § 103

Process

I. Claims **1-10** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Doyle et al.** (US Patent No. 5,628,426) in combination with **Paul** (US Patent No. 5,411,014).

The rejection of claims 1-10 under 35 U.S.C. 103(a) as being unpatentable over Doyle et al. in combination with Paul is as applied in the Office Action dated May 9, 2002 and incorporated herein. The rejection has been maintained for the following reasons:

Applicant states that Doyle teaches treating the exterior surface by polishing. A coating cannot be applied to a polished surface as it would not stay on. Thus, Doyle teaches away from applying a coating, such as enamel, which is disclosed as being applied to the outer surface of the pan. In response, it is well within the skill of the artisan to substitute the polishing of the outer surface of the frying pan with enamel coating the outer surface of the frying pan because Doyle and Paul are doing the same endeavor of surface treating the outer surface of a frying pan. The disclosure of

reference must be considered for what it fairly teaches one of ordinary skill in the art, pertinence of non-preferred disclosure must be reviewed in such light. *In re Meinhardt* 157 USPQ 270; and MPEP § 2123.

Applicant states that Paul does not contemplate applying an enamel coating to a hard-anodized surface. In response, the present methods do not apply an enamel coating to a hard-anodized surface. The enamel coating is applied to the *exterior* surface of the article and the *interior* surface of the article is hard anodized.

It is well settled that unpatented claims are given the broadest, most reasonable interpretation and that limitations are not read into the claims without a proper claim basis therefore. *In re Prater* 415 F. 2d 1393, 162 USPQ 541 (CCPA 1969); *In re Zeltz* 893 F. 2d 319, 13 USPQ 1320.

Applicant states that if one proceeded to apply the enamel coating to the exterior surface, the coating would not be “visually pleasing”. In response, apart from the fact that it can serve a decorative purpose, the enamel coating can improve wear resistance, scratch resistance, corrosion protection or thermal conductivity independently of the coating system to be provided on the inside of the frying pan.

Applicant states that the application of two enamel coatings, separated temporally time by a hard-anodizing process, would not be considered to be a routine

expedient. In response, Doyle teaches treating the interior and exterior surfaces of the frying pan separately in time. The interior surface of the frying pan is hard anodized and then coated with a non-stick material (col. 5, lines 16-22) and then the exterior surface of the frying pan is polished (col. 5, lines 24-25). Thus, treating the interior and exterior surfaces of the frying pan separately in time is well within the skill of the artisan (also see Paul, Fig. 5, esp., blocks **43** and **49**).

As to claim 1 reciting the application of two separate enamel coatings for overcoming the difficulty associated with applying an enamel coating to a hard-anodized surface below, claim 1 does not recite applying an enamel coating to a hard-anodized surface. The enamel coating is applied to the *exterior* surface of the article and the *interior* surface of the article is hard anodized. The claimed enamel coatings are not applied to the *interior* surface of the article.

It is well settled that unpatented claims are given the broadest, most reasonable interpretation and that limitations are not read into the claims without a proper claim basis therefore. *In re Prater* 415 F. 2d 1393, 162 USPQ 541 (CCPA 1969); *In re Zeltz* 893 F. 2d 319, 13 USPQ 1320.

Applicant states that the method of claim 1 is not a duplication of parts but a recognition that the conventional prejudice against applying enamel to a hard-anodized surface can be overcome, claim 1 does not recite applying an enamel coating to a hard-anodized surface. The enamel coating is applied to the *exterior* surface of the article

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and the *interior* surface of the article is hard anodized. The claimed enamel coatings are not applied to the *interior* surface of the article.

It is well settled that unpatented claims are given the broadest, most reasonable interpretation and that limitations are not read into the claims without a proper claim basis therefore. *In re Prater* 415 F. 2d 1393, 162 USPQ 541 (CCPA 1969); *In re Zeltz* 893 F. 2d 319, 13 USPQ 1320.

Applicant states that the first enamel surface is severely degraded by the hard anodizing process. This degraded surface of the first enamel surface is then used as a base for applying the second enamel coating. In response, the first enamel coating as presently claimed is applied to the *exterior* surface of the article. The *interior* surface of the article is hard anodized. It is unclear how the first enamel surface on the exterior surface of the article is severely degraded by the hard anodizing process when it is the interior surface of the article that is subjected to the hard anodizing.

Thus, the first and second enamel coatings as presently claimed are superposed enamel coatings.

Applicant states that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the

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time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant states that Paul does not disclose the temperature utilized, nor any such remelting effect. In response, the Examiner maintains the position that the infrared curing disclosed by Paul would have been at a temperature high enough to remelt the surface of the first porcelain enamel coating to some degree, absent evidence to the contrary. Applicants' remarks have been fully considered but they are not deemed to be persuasive.

With regard to product claims 12 and 13, the invention defined in a product by process claim is a product, not a process. *In re Bridgeford* 679, 149 USPQ 55 (CCPA 1966). It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown* 459 F. 2d 531, 173 USPQ 685 (CCPA 1972); *In re Wertheim* 541 F. 2d 257, 191 USPQ 90 (CCPA 1976).

As evidence by the teachings of Doyle and Paul, a frying pan with a hard anodized/non-stick coating interior surface is conventional and a frying pan with an enamel coated exterior surface is conventional. Surface treating the interior and exterior surfaces of the frying pan with such a combination is well within the skill of the artisan dependent upon the intended use of the frying pan, particularly to the environment to

which the frying pan will encounter, which would be most suited for the application of the frying pan, absent evidence to the contrary.

Process and Product

II. Claims **11 and 13** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Doyle et al.** (US Patent No. 5,628,426) in combination with **Paul** (US Patent No. 5,411,014).

The rejection of claims 11 and 13 under 35 U.S.C. 103(a) as being unpatentable over Doyle et al. in combination with Paul is as applied in the Office Action dated May 9, 2002 and incorporated herein. The rejection has been maintained for the above reasons.

Product

III. Claim **12** has been rejected under 35 U.S.C. 103(a) as being unpatentable over **Doyle et al.** (US Patent No. 5,628,426) in combination with **Paul** (US Patent No. 5,411,014).

The rejection of claim 12 under 35 U.S.C. 103(a) as being unpatentable over Doyle et al. in combination with Paul is as applied in the Office Action dated May 9, 2002 and incorporated herein. The rejection has been maintained for the above reasons.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (703) 308-3818. The examiner can normally be reached on Mon-Fri 7:30 am to 5:00 pm, alt. Fridays off.

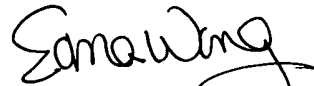
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (703) 308-3322. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 873-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-

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0661.

A handwritten signature in black ink, appearing to read "Edna Wong", with a large, stylized loop at the end.

Edna Wong
Primary Examiner
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EW
November 25, 2002